

REMARKS

Claim Rejections

Claims 1, 3, 4, 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldman (U.S. 2,498,074) in view of Spector (U.S. 5,897,418). Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldman in view of Spector and further in view of Kaplan et al. (U.S. 5,261,848). Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldman in view of Spector and further in view of Horiuchi (U.S. 5,301,444).

Amendments to Specification

Applicant has amended the specification as noted above to provide antecedent basis for the handle, illustrated in the drawings as originally filed with this application. No “new matter” has been added to the original disclosure by the foregoing amendments to the specification.

Abstract of the Disclosure

Applicant is submitted a substitute Abstract of the Disclosure for that originally filed with this application to more clearly describe the claimed invention. It is believed that the substitute Abstract of the Disclosure overcomes the objections set forth in the outstanding Office Action. Entry of the substitute Abstract of the Disclosure is respectfully requested.

Drawings

Applicant proposes to amend Figures 3 and 9, as illustrated in red on the attached photocopies. In Figure 3 it is proposed to add reference number --14--. In Figure 9 it is proposed to add reference number --14'--. No “new matter” has been added to the original disclosure by the proposed amendments to these figures. Approval of the proposed drawing changes is respectfully requested.

It is noted that no Patent Drawing Review (Form PTO-948) was received with the outstanding Office Action. Thus, except for the above proposed drawings corrections, Applicant must assume that the drawings are acceptable as filed.

New Claims

By this Amendment, Applicant has canceled claims 1-7 and has added new claims 8-19 to this application. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

New claims 8-13 are directed toward a toy pet box comprising: a pen (9); a body (1) connected to a top of the pen and having: an enclosed transparent outer shell (11); a hollow interior (12) for holding water; a water inlet (13) located on an outer surface of the transparent shell and communicating with the hollow interior; and a sealing cap (131) removably connected to and sealing the water inlet; at least one expandable toy (2) located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior.

New claims 14-19 are directed toward a toy pet box comprising: a body (1) having: an enclosed transparent outer shell (11); a hollow interior (12) for holding water; a water inlet (13) located on an outer surface of the transparent shell and communicating with the hollow interior; a sealing cap (131) removably connected to and sealing the water inlet; and a carrying handle (14, 14') connected thereto; and at least one expandable toy (2) located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior.

Other embodiments of the present invention include: each of the at least one expandable toy is connected to a surface of the hollow interior of the body; each of the at least one expandable toy is detached from surfaces of the hollow interior of the body; each of the at least one expandable toy includes a weight (20') located at a predetermined location; at least one decorative sticker (4, 5) connected to a surface of the body; at least one ornament (3') connected to an interior surface of the body.

The primary reference to Feldman discloses a method of making novelty displays including prepare an expandable resin body, inserting the expandable resin body into a container, and expanding the expandable resin body within the container.

Feldman does not teach a pen; a body connected to a top of the pen; a body having a sealing cap removably connected to and sealing the water inlet; each of the at least one expandable toy is connected to a surface of the hollow interior of the body; each of the at least one expandable toy includes a weight located at a predetermined location; at least one decorative sticker connected to a surface of the body; at least one ornament connected to an interior surface of the body; nor does Feldman teach a body having a carrying handle connected thereto.

The secondary reference to Spector discloses a test tube doll package including an expandable figure (F) located in a test tube (T) under a vacuum. When a stopper (19) of the test tube is removed, thereby moving the vacuum, the figure will expand.

Spector does not teach a pen; a body connected to a top of the pen; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; each of the at least one expandable toy includes a weight located at a predetermined location; at least one ornament connected to an interior surface of the body; nor does Spector teach a body having a carrying handle connected thereto.

The secondary reference to Kaplan discloses a toy with a liquid-filled shell including a figure (14), a base (12), and a housing (16) removable located on the base. The housing includes an inner transparent shell portion (36), an outer transparent shell portion (38), and an enclosed cavity (40) filled with a liquid (42) with reflective particles (46).

Kaplan et al. do not teach a pen; a body connected to a top of the pen; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; each of the at least one expandable toy includes a weight located at a predetermined location; at least one decorative sticker connected to a surface of the body; at least one ornament connected to an interior surface of the body; nor does Kaplan et al. teach a body having a carrying handle connected thereto.

The secondary reference to Horiuchi discloses a swimming toy fish including a liquid vessel (1) with a background plate (6), and a swimming toy fish (20) with an air tank (22) and a magnetic member (23).

Horiuchi does not teach a pen; a body connected to a top of the pen; at least one expandable toy located in the hollow interior and expandable therein from an original size to an expanded size when water is placed in the hollow interior; each of the at least one expandable toy is connected to a surface of the hollow interior of the body; at least one decorative sticker connected to a surface of the body; at least one ornament connected to an interior surface of the body; nor does Horiuchi teach a body having a carrying handle connected thereto.

Even if the teachings of Feldman, Spector, Kaplan et al., and Horiuchi were combined, as suggested by the Examiner, the resultant combination does not suggest: a pen; a body connected to a top of the pen; at least one ornament connected to an interior surface of the body; nor does the combination suggest a body having a carrying handle connected thereto.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Feldman, Spector, Kaplan et al., or Horiuchi that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Feldman, Spector, Kaplan et al., nor Horiuchi disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new claims.

Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: July 14, 2004

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